

REMARKS

Claims 15 to 29 are pending in the present application. (The Office Action lists Claims 15 to 27 as pending. (*Applicants believe claims 28 and 29 were mistakenly omitted from this listing, since claims 15 to 29 are plainly pending*)).

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement (IDS), 1449 paper, and cited references.

Applicants respectfully request that the Examiner (in the next Office Action) acknowledge the claim for foreign priority, and indicate whether certified copies of the priority documents have been received.

Claims 15 to 19, 21, 22 and 25 to 27 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Application No. 2002/0166531 ("Ackermann").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claim 15 has been rewritten to provide for the features of “performing a *retardation* involving at least one of: *time-retarding a starting discharge instant of the discharge valve with respect to a standard discharge instant* used during the at least one additional operating mode, and *time-retarding an opening instant and a closing instant of the intake valve with respect to a standard closing instant* used during the at least one additional operating mode, the intake valve being used during the start-up operating mode for an aspiration of a fresh gas.”

In contrast, the “Ackermann” reference only refers to shortening a compression phase by early or late closing of an intake valve. This is clearly not the same as and does not correspond to *time-retardation*, as provided for in the context of the claimed subject matter. The Ackermann reference refers to reducing an overall time during which the intake valve is open, whereas time-retardation does not require shortening of the opening duration. With time-retardation, the duration may remain substantially the same, while the opening and closing times are *shifted* relative to their conventional positions. Claim 15 specifically provides for “*time-retarding an opening instant and a closing instant of the intake valve.*” This shifts the open duration of the intake valve by delaying both the moment of opening and the moment of closing. The “Ackermann” reference only refers to late closing while using “conventional” opening times. Thus, the “Ackermann” reference does not identically disclose (or even suggest) the feature of time-retardation as provided for in the context of claim 15, as presented.

Accordingly, claim 15 is allowable, as are its dependent claims 16 to 19, 21 and 22.

Claims 25 to 27, as presented, include features analogous to those of claim 15, as presented, as explained above. Accordingly, claims 25 to 27 are allowable for at least the same reasons as claim 15, as presented.

Claim 20 was rejected under 35 U.S.C. § 103(a) as obvious over the “Ackermann” reference in view of German Patent Application No. 19960984 (Sieber).

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438

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(Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 20 depends from claim 15, as presented, and is therefore allowable for essentially the same reasons as claim 15, since the secondary Sieber reference does not cure – and is not asserted to cure – the critical deficiencies of the primary reference.

Claims 23 and 24 were rejected under 35 U.S.C. § 103(a) as obvious over the “Ackermann” reference.

Claims 23 and 24 depend from claim 15 and are therefore allowable for essentially the same reasons as claim 15, as presented.

Also, claims 28 and 29 (*which were not addressed in the Office Action*) depend from claim 27, as presented, and are therefore allowable for essentially the same reasons as claim 27.

In sum, claims 15 to 29 are allowable.

Conclusion

In view of the foregoing, it is respectfully submitted that all of presently pending claims 15 to 29 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. All issues raised by the Examiner have been addressed, so that an early and favorable action on the merits is respectfully requested.

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